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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/001,766

10/31/2001

Yoshizumi Mano

09812.0171-00000

4322

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7590

08/16/2007

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

08/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/001,766

Applicant(s)

MANO ET AL.

Examiner

Dennis Ruhl

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's amendment of 6/4/07 has been entered. Currently claims 1-9 remain pending and claims 10-15 remain non-elected and withdrawn. The examiner will address applicant's remarks at the end of this office action.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 2,3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In claims 2,3, the language of "the settlement means prepares and stores a document associated" seems to be a method of using recited structure of an apparatus claim, which renders the claim as non-statutory. Claim 3 recites "the output means provides" is a method step of using recited structure of an apparatus type of claim. A claim must be directed to just one of the distinct statutory classes of invention. In this case, claims 2 and 3 appear to be mixing both apparatus and method statutory classes of invention. The examiner suggests using language such as "said settlement means" is further operable to prepare and store a document, or something to that affect.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 1, it is still not clear as to what the scope of some of the means plus function language is (112,6th). Claim 1 recites a 1st and 2nd input means that function to receive data via a network. Claim 1 is an apparatus type of claim where structure is what is to be claimed and given patentable weight. The data itself that is to be received by the various input means is not part of the structure being claimed. The structure does not change dependent on what kind of data is being received. It is not clear what structure each of the recited "input means" is supposed to have. How does the 1st input means differ structurally from the 2nd input means? Taking into consideration that each input means is recited as "for receiving" data, where the data itself is not part of the structure (the kind of data is the intended use as well as non-functional descriptive material), the function for each input means is the same, so what is the difference between the 1st, 2nd 3rd, etc.? It seems to the examiner that structurally, the input means that allows data to occur is the same regardless of who is sending the data that is to be received and regardless of the kind of data received. This seems especially true because all of the input means are claimed as receiving the data from the same network, not different networks. What is the corresponding structure from the specification that is covered by the language 1st and 2nd input means, and further, how do the 1st and 2nd input means differ from each other structurally? This is still not clear

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and one wishing to avoid infringement would not understand what the scope of the claim is, so the claim is indefinite.

For claims 3,4, the same problem is present that is found in claim 1, namely that it is not clear how the 3rd input means differs from the 1st and 2nd input means, and it is not clear as to what the corresponding structure is from the specification that is covered by the 3rd input means recitation? This is not clear. The same applies to the 4th input means, how is this means different from any of the 1st, 2nd, or 3rd input means? Also, for claim 4, how is the 2nd recording means different from the 1st recording means? What structure is covered by each of the 1st and 2nd recording means? This is not clear.

For claims 2,3, the scope of the claim is not clear. This is because applicant has claimed that the settlement means "prepares and stores a document". This is seen as a positive recitation to a method step in an apparatus type of claim, where recited structure of now being claimed as performing a particular method step. It is not clear to one wishing to avoid infringement under what conditions infringement would occur. Is just having the claimed system infringement, or does one have to have the claimed system and use it by having the settlement means actually "prepare and store" a document? This is not clear because the way the claim language is written. The examiner suggests using language such as "said settlement means" is further operable to prepare and store a document, or something to that affect.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 7,8 are rejected under 35 U.S.C. 102(b) as being anticipated by the well known prior art act of selling the broadcast rights for a television program to a broadcaster (CBS, ABC, etc.) as has been done for years with “syndicated television programming”. The examiner takes “official notice” that this method was on public use more than one year prior to the filing date of the instant application (in support of this position the examiner has cited an article entitled “Syndication”).

For claims 7,8, when the rights to broadcast a television program are bought, it is inherent that information concerning the content (what kind of program) and the broadcasting rights (what are the actual specific broadcast rights being sold) associated with the content would be received. When the rights are purchased, this is the same as attaching the right to broadcast the program to the content itself. The rights belong to the respective media content, and in this sense are attached as claimed. Claim 7 uses no technology and is more or less reciting the old and well-known prior art act of purchasing the broadcast rights to broadcast a particular television program, which is disclosed by the cited reference.

7. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferstenberg et al. (5873071).

For claim 1, Ferstenberg discloses a system and method for the sale of commodities. Ferstenberg discloses an intermediary system 40 (a computerized

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system; i.e. a server) that allows buyers and seller of a commodity to interact and negotiate with each other concerning the purchase of the commodity. The intermediary system receives information from sellers of commodities and allows buyers to view the information received from sellers. The commodity that is being sold can be anything from stocks and bonds to tangibles such as copper or soy beans, see column 1, lines 14-25. With respect to the limitation that the data to be received is "media content information", this is directed to non-functional descriptive material that does not define any structure to the system being claimed. The data that is to be received has nothing to do with the structure of the claimed elements that actually receive the data. The limitation of "media content information" is directed to the intended use of the system that does not result in a structural difference from that of the prior art. Ferstenberg discloses that there are seller computers and buyer computers, which are the client systems disclosed in column 39. Each client system is connected via a network to intermediary system 40. The claimed first input means is considered to be the hardware and software that the system 40 would necessarily be required to have so that data can be received from a seller. This can be a modem and the software that allows data to be received. The intermediary system 40 inherently has an input means. It must have an input means so that the system can receive data from the sellers and buyers of various commodities as disclosed by Ferstenberg. The first recording means is considered to be the database of the system 40 and the software that controls the saving of data. This is also inherent to the system 40. The claimed output means is the hardware and software that allows system 40 to send out communications to the clients.

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For system 40 to be able to send communications to the client systems, an output means is necessarily required. The second input means (as best understood by the examiner) is also satisfied by the hardware and software that the system 40 would necessarily be required to have so that data can be received from a buyer of the commodity. This can be a modem and the software that allows data to be received from the buyer. The *settling means* that is for settling a "purchase-and-sale contract" is considered to be the hardware and software that allows the negotiation between the seller and buyer to occur, which results in the a sale occurring. The act of negotiation is done to allow a contract for sale to be arrived at and once that is accomplished, a contract is the result. This satisfies what is claimed. With respect to the fact that claim 1 is reciting that the information received is concerning "media content information", as stated previously, this has been considered but as far as the system goes, this defines nothing to the system that is not found in Ferstenberg and is directed to the intended use of the system. This is because the commodity that is being sold is not part of the system and claiming a specific commodity does not change the overall system. Because Ferstenberg can be used with any kind of commodity and because the system is what is being claimed in claim 1 (not the method), Ferstenberg anticipates what is claimed. The recitation that it is "media content information" that is being sold does not result in a structurally different system from that of Ferstenberg.

For claim 2, the negotiation aspect of Ferstenberg results in the formation of and storage of a document (the transmitted offers and counteroffers) regarding the sale of the commodity. This satisfies what is claimed.

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For claim 3, as best understood by the examiner the 3rd input means is satisfied by the input means discussed with respect to claim 1. It is also considered inherent to Ferstenberg that there is a "search means" that will search for matching information that matches the information submitted from the buyer. This is necessarily present in Ferstenberg because when a buyer submits an order for a particular commodity, the system 40 must have some way of determining what clients can satisfy the order desired by the buyer. This is how the matching of a selling client to a buying client happens. The outputs means as best understood by the examiner is satisfied by the output means discussed with respect to claim 1. The system 40 cannot assist in the conducting of a transaction if it cannot be determined who has offered a particular commodity for sale that a buyer has expressed an interest in purchasing. As stated previously, the kind of data intended to be received by various claim elements is directed to the intended use of the system and is considered to be non-functional descriptive material that does not serve as a limitation.

For claim 4, as best understood by the examiner, the 3rd and 4th input means are satisfied by the input means discussed with respect to claim 1. The system 40 stores information concerning the sellers and buyers that interact with system 40.

For claim 5, this claim is reciting nothing further structurally to the system of claim 1. This is because the "media content rights" are not a structural part of the system. The rights are just what the system is used to sell. Additionally, "rights" are not even a real world tangible thing that can be claimed, so the examiner cannot possibly

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give weight to what is claimed. A "right" is not a real world thing, but is more of an intangible thing. Claim 5 is directed to non-functional descriptive material.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferstenberg et al. (5873071).

For claims 6-9, Ferstenberg discloses a system and method for the sale of various commodities. Ferstenberg discloses an intermediary system 40 (a computerized system; i.e. a server) that allows buyers and seller of a commodity to interact and negotiate with each other concerning the purchase of the commodity. The intermediary system receives information from sellers of commodities and allows buyers

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to view the information received from sellers. The commodity that is being sold can be anything from stocks and bonds to tangibles such as copper or soy beans, see column 1, lines 14-25. Ferstenberg discloses that there are seller computers and buyer computers, which are the client systems disclosed in column 39. Each client system is connected via a network to intermediary system 40. The claimed receiving first content is considered to be satisfied by the fact that data is received from a seller regarding what commodities are for sale (column 17, lines 51-63). This information is recorded as claimed. The claimed outputting step is the sending of information to the buyer. This would be information regarding what the seller is selling and would be notification to the buyer that a transaction may be able to be made. The settlement step is disclosed in step 14 of Ferstenberg. Ferstenberg disclose that negotiation between the seller and buyer occurs by the transmission of offers and counter offers. The act of negotiation is done to allow a contract for sale to be arrived at and once that is accomplished, a contract is the result. The act of viewing offers and counter offers satisfies the claimed viewing of web pages as claimed. The offers and counter offers are messages as claimed. With respect to the fact that claim 1 is reciting that the information received is concerning "media content", this is not disclosed by the prior art. Also not disclosed is that information is received indicating the purchase rights of the media content. Because it is disclosed that the commodities can be stocks and bonds, or real world tangible goods (copper), one of ordinary skill in the art would have recognized that the system of Ferstenberg could be used for the selling and buying of any kind of commodity. Because it is very well known in the art to one of ordinary skill in the art that

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"program content" (broadcasting rights of some kind of media content) is sold by "content producers" and that content is purchased by "broadcasters", one of ordinary skill in the art at the time the invention was made would have found it obvious to use the system of Ferstenberg for the sale and purchase of television programming rights. This is just using the Ferstenberg for another type of commodity that is widely recognized as already being bought and sold by those involved in television and the media. When one is selling media content, it is considered inherent that there is information indicating what the actual rights are that are being purchased. The rights that are claimed as being received are necessarily involved in the selling of broadcast rights for media content, as is very well known in the art.

For claim 7 in addition to that above, when a program is sold by using the system of Ferstenberg, this is "attaching" the "right" to broadcast the purchased media content to the content itself. When a buyer negotiates the purchase of media content by using the system of Ferstenberg, and a sale is made, this is a granting of the "right" for the buyer to broadcast the purchased media content. This satisfies what is claimed.

11. Applicant's arguments filed 6/4/07 have been fully considered but they are not persuasive.

With respect to the 112,6th language of "means for receiving" data "via a network", the arguments are not persuasive. Applicant has argued that the specification discloses the associated structure, but the language applicant has relied upon in the specification does not resolve this issue. Each input means is claimed as being for

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receiving data from the network. Each input means is claimed as performing the same function, which is the receipt of data. The kind of data that is intended to be received has nothing to do with the claimed structure that is covered by this 112,6th language. The data to be received is directed to the intended use of the input means and is also considered to be non-functional descriptive material that does not serve as a limitation. Applicant has referred to pages 29 and 31 for a showing of what the disclosed structure is that is covered by this language, and to show that the structure is different between the 1st and 2nd input means. With respect to the first input means applicant has referred to the language about data being output by a catalog management server, where the output is *to a firewall 37 and a database server 61-1 and 61-2*. The claim language is directed to a means for receiving, so the element of a catalog management server that outputs the data is not being claimed. The function is not the same as recited, which is output versus receiving. The examiner questions as to where is it disclosed to a reasonable degree of particularity that the input means is the *combination of both* the firewall and the database server? This is not stated in the specification. The examiner believes that applicant's position on this issue does not have support in the specification, as it was never stated that a combination of two elements is actually covered by a means for receiving limitation. The examiner also notes that for the second input means applicant has relied upon page 31, where it is recited that there is an order management server that outputs data "*via the firewall 37 and the database server 61-1 or 61-2*". The 2nd input means is recited with respect to a discussion about the firewall 37 and the database server 61-1 or 61-2, just as was relied upon for the 1st

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input means for receiving. Applicant seems to be arguing that the 1st and 2nd input means are different in structure, but the specification discloses that the data in each case is output to the same firewall and same database server 61-1 or 61-2. This seems to be more or less arguing that the structure of the 1st and 2nd input means is the firewall and the database server for both the 1st and 2nd input means for receiving, which means the structure is the exact same for both input means and that there is really only one input means, not a plurality. Also, the database itself that is storing the data cannot be fairly considered to be a means for receiving the data from the network as a database stores data after it has been taken from the network and processed for storage. Taking all of this into account, it is not clear as to what structure is defined by the claim language of "input means" in regards to 1st, 2nd, 3rd, input means. Are they the same and if they are not, it is not clear on the record as to how they differ. The rejection is maintained.

With respect to the traversal of the 102(b) rejection, it is not persuasive. Applicant has argued that the rejection does not have media content rights being sold along with the rights "attached" to the media content. This argument is somewhat confusing in the sense that a "right" is not a real world tangible thing. A "right" is an abstract idea or a concept. A "right" is not a physical object that is being attached (glued or stapled as examples) to media content. To the extent that applicant is and has the ability to attach an abstract idea to a media content, this is in the prior art rejection of record. When rights to a television program are sold, the "right" to broadcast is attached to the program for which the rights were purchased. To that

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extent, the rights are attached to the media content as claimed. Also, the argument that there are no rights being sold is not persuasive. The cited article from the examiner (Syndication) specifically discloses, "*Syndication is the practice of selling rights to the presentation of television programs*". Also disclosed is "The syndication of television programs is a fundamental financial component of television industries" and "syndication is now a worldwide activity, involving the sales of programming produced in many countries". To argue that this cited article does not disclose the selling of the media content is not persuasive. When somebody is purchasing the rights to broadcast a television program, they are purchasing both the right and the content itself. They must have the media content to be able to broadcast it, which is the right that has been purchased. Applicant's argument is not persuasive.

Concerning the traversal of the examiner taking "official notice", the cited article already provides evidence of the fact that it is very well known in the art to sell media content. The evidence clearly and unquestionably supports this position. The cited article from the examiner (Syndication) specifically discloses, "*Syndication is the practice of selling rights to the presentation of television programs*". Also disclosed is "The syndication of television programs is a fundamental financial component of television industries" and "syndication is now a worldwide activity, involving the sales of programming produced in many countries". To argue that this article does not disclose the selling of the media content is without merit. Applicant's argument also seems to contradict the statement on page 14 of "Syndication discloses the practice of selling rights to the presentation of television programs". Applicant is challenging the taking of

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"official notice" by the examiner by essentially stating that the cited reference does not disclose the selling of rights, which contradicts applicant's own characterization of the very same article (page 14, 1st full paragraph). The cited article provides evidence that support the taking of "official notice" by the examiner.

Regarding the traversal of the 102(b) rejection using Ferstenberg, it is not persuasive. Claims 1-5 are apparatus types of claims. The data that is intended to be received by the various claimed elements is not part of the claimed structure of the overall apparatus. The data defines no structure to the overall system as claimed. The data is directed to non-functional descriptive material, as it is just what the system uses and it not being processed in any particular manner. The data is not being claimed and defines no structure to the claimed system. The prior art discloses structure that satisfies what is claimed, and is fully capable of receiving any kind of data concerning a commodity that is to be sold. The prior art does not have to disclose the actual receipt of media content data, because these claims are not method claims. These claims are apparatus claims. There is no data being received, just claimed structure to a system that is intended to receive this kind of data. The prior art satisfies and discloses the structure that is claimed. Applicant is essentially arguing that the kind of data that the system is intended to receive should render the system patentable. This is not a persuasive argument.

For the 103 rejection, applicant is not addressing the obviousness rejection as set forth by the examiner. The examiner admitted that Ferstenberg does not disclose the receiving and selling of media content. That is the limitation that is being addressed

in the 103 obviousness rejection. The examiner then stated why it is considered obvious to use the system of Ferstenberg to sell media content and broadcasting rights. The examiner has relied upon the knowledge that one of ordinary skill in the art would possess, in addition to the disclosure of Ferstenberg, for the showing of obviousness. The Ferstenberg reference is not being viewed as if it were in a vacuum. Applicant has ignored the portion of the rejection where the examiner relies upon the very well known fact that media content and the rights to broadcast the media content are sold. Applicant has not addressed the reasoning set forth by the examiner in the rejection. The argument is not persuasive for this reason.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER